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10/728,219	12/03/2003	Brian John Roberts	21204.0211US	7993
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EXAMINER				
LEIVA, FRANK M				
ART UNIT		PAPER NUMBER		
3717				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/728,219

Applicant(s)

ROBERTS, BRIAN JOHN

Examiner

FRANK M. LEIVA

Art Unit

3717

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-34 and 36-61 is/are pending in the application.
4a) Of the above claim(s) 40-42 and 56-59 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 27-34, 36-39, 43-55, 60 and 61 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 September 2010 has been entered.

Acknowledgements

2. The examiner acknowledges no amendments to claims in applicant's submission filed 16 September 2010.

Response to Arguments

3. Applicant's arguments filed 16 September 2010 2009 have been fully considered but they are not persuasive. Persuasiveness considerations as follows;

4. Regarding the argument on page 2 of applicant's remarks in regards of the rejoinder of claims 40-42 and 57-59; The examiner points to MPEP 821.04 [R-3] the restriction requirements of claims 40-42, 57-59; "*In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim.*"

Since the independent claims are still being rejected, the argument is not persuasive.

5. Regarding the argument on page 3 of applicant's remarks in regards to claims 27-38, 43-54, 60 and 61; "Kaye does not, however, teach a hybrid ticket having plays for multiple different types of games. In this respect, Kaye does not teach that a player might select a ticket having **both** a preprinted instant lottery game **and** a play in a second interactive Internet game." The examiner points that the argument is not within the scope of the claims, since claim 27 is specific to the player purchasing a hybrid ticket or purchasing a lottery

ticket without the virtual game, Not purchasing a ticket having both games, (i.e. also usable in an interactive game), where also usable for an interactive game does not mean having both preprinted instant lottery game and a play in a second game.

6. Regarding the argument on page 3 of applicant's remarks in regards to claims 27-38, 43-54, 60 and 61; "*Kaye does not describe that a player might make a selection between a "Destiny Code" game and a non "Destiny Code" game, much less that a player might select a game based on a preprinted instant lottery ticket.*" The applicant is correct, yet the argument is not relevant to the rejection since it is Roberts' disclosure that teaches the selection of tickets with or without the feature game.

7. Regarding the argument on page 4 of applicant's remarks in regards to claims 27-38, 43-54, 60 and 61; "*The comment in the recent Office Action that Roberts provides 62 mentions of a computer is irrelevant to the question of whether or not Roberts teaches an interactive Internet game as claimed. There is nothing about any of Roberts' games themselves that could accurately be described with both of the adjectives "interactive" and "Internet."*" Roberts column 4 lines 35-50, in which the player has to rub off material then insert ticket into the on-line terminal (Internet) where the unit sends to a computer and have the system complete the ticket. There is enough activity between the player and the system to be considered interactive, since the ticket cannot be completed without player interaction.

8. Regarding the argument on page 5 of applicant's remarks in regards to claims 27-38, 43-54, 60 and 61; "*Given the disparate teaching of these two references, with Kaye describing a "Destiny Code" based system that is used to allow for play of a computer based game, and Roberts describing a hybrid ticket that does not involve any computer based play, it is not clear how these references could even be combined. Indeed, given the significant differences between the references, the proposed combination is improper.*" The applicant has failed to present a persuasive argument that the teachings of Kaye and Roberts are disparate; Both inventions are directed to Lottery systems that require a printed ticket; Both teach a printed ticket with a special extra feature; and Both teach that it requires an internet network computer system or on-line device to complete the game played in the ticket.

It is the examiner's position on the 35 U.S.C. §103(a) Patent Law, and interpretation of the KSR Ruling; that a combination of features or limitation already in existence and being of analogous art, not just Gaming, but being as precise as related to a Lottery Game, would be all obvious to one of ordinary skill, and that any iterations of the combinations of these limitations would be predictable without hindsight unless a specific teaching against the combination is present. An inventive step, something out of the ordinary should be present in order to invoke improper hindsight.

9. Regarding the arguments on page 6 of applicant's remarks in regards to claims 39 and 55; The examiner has traverse the arguments of the independent claims and finds applicants argument directed to the dependency of these claims not persuasive.

10. For the above reasons mentioned, the examiner deems the arguments not persuasive and the rejections proper.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 27-34, 36-38, 43-54 and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (US 5,569,082), in view of Roberts (US 5,772,510).** Regarding the analogous art combination; Kaye discloses a Personal Computer Lottery Game that includes a special Destiny code or hidden prize code as a feature in a Lottery Ticket; Roberts discloses a ticket dispensing method where the players have a choice to buy tickets with or without certain special features. Both inventions disclose Lottery Ticket Systems.

13. Regarding claims 27 and 48; Kaye discloses:

A lottery gaming system, comprising: a lottery ticket, the lottery ticket including a ticket identifier, an interactive game information, and an instant game information, and a removable covering concealing the instant game information, (col. 1:25-35).

A lottery ticket dispenser configured to dispense the lottery ticket, (col. 4:40-52).

The lottery ticket dispenser configured, responsive to receiving the input indicating the player's choice to purchase the lottery ticket, (col. 4:40-52), without activating the lottery ticket for use in the interactive Internet game, to dispense the lottery ticket without activating the lottery ticket for use in the interactive Internet game, (col. 7:45-54; where a player may choose on a menu to play either a simple "lotto" game or an interactive "horses game" using a lottery ticket).

A central computer system in communication with the lottery ticket dispenser and configured to receive from the lottery ticket dispenser an indication that the player has chosen to purchase the lottery ticket for use in the interactive Internet game, the central computer system configured to, responsive to the receipt of the indication, to activate the lottery ticket for use in the interactive Internet game, (col. 4:40-52; where a central single computer network controls lottery information and distribution), and a computing device remote from and in communication with the central computer system via the Internet, the computing device configured to receive the interactive game information from the lottery ticket, the computing device further configured to be utilized by the player to play the interactive Internet game based at least in part on the interactive game information, (col. 3:4-12), (Fig. 6), "on-line service"(Internet).

Kaye fails to disclose games without the features of his invention (destiny bonus), yet shows the ability of the player to choose among a selection of different games.

Roberts discloses: A lottery ticket dispenser configured to dispense the lottery ticket, the lottery ticket dispenser including an input device configured to receive, prior to the lottery ticket being dispensed, an input indicating a player's choice between purchasing the lottery ticket as a hybrid instant lottery ticket that is also usable in an interactive Internet game and purchasing the lottery ticket without activating the lottery ticket for use in the interactive Internet game, (fig. 7 and description; whereas the

dispenser contains games that are scratch off and games that are not), interactive because it requires action by the player to remove media from the ticket and to enter it into a network Internet system to complete the ticket.

a preprinted instant lottery ticket, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the vending machine style of Roberts to the Kaye invention to reach more types of gamblers and combined them into a single system as an application of well known dispensing apparatuses.

Very little is required to combine the optional interactive game of Roberts into Kaye's invention, since Kaye already teaches the additional interactive game, Roberts just discloses the sale of tickets without special features or standard tickets. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention, to continue selling the previous type of lottery ticket along with the new feature ticket so as to not loose the previously establish clientele following and allow for more selections for the players.

14. Regarding claims 28 and 50; Kaye discloses a lottery gaming system wherein the lottery ticket dispenser includes a printer configured to print the interactive game information on the lottery ticket responsive to the indication that the player has chosen to purchase the lottery ticket for use in the interactive Internet game (col. 3:4–12, Fig. 6).

15. Regarding claims 29 and 49; Kaye and Roberts disclose all the limitations of claims 27 and 48 from which claims 29 and 49 depend on; and Roberts further discloses a lottery game system wherein the lottery ticket is pre-printed with the interactive game information, the ticket dispenser including a reader configured to read the ticket identifier from the lottery ticket prior to the ticket being activated for use in the interactive Internet game, (col. 4:7-21), wherein the preprinted barcode is read by the

dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

16. Regarding claim 30; Kaye and Roberts disclose all the limitations of claims 27 and 29 from which claim 30 depends on; and Roberts further discloses a lottery game system, wherein the reader is configured to read the ticket identifier from the lottery ticket prior to the lottery ticket being dispensed, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

17. Regarding claims 31 and 51; Kaye and Roberts disclose all the limitations of claims 27, 29 and 48 from which claims 31 and 51 depend on; and Roberts further discloses a lottery game system, wherein the ticket dispenser is further configured to communicate the ticket identifier read from the lottery ticket to the central computer, (col. 4:7-21), wherein the preprinted barcode is read by the dispenser previous to printing the activation information on the selected card. Since Roberts uses a scanner to identify the type of card being purchased it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the scanner in the Kaye/Roberts combination already made above in claim 27. It would be required to identify the type of card before printing.

18. Regarding claims 32 and 53; Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are encoded in a bar code (col. 2:55—

58; col. 3:7–12; where a bar code is a type of symbolic encryption that may be used to encrypt destiny codes that may be stored on a paper medium).

19. Regarding claim 33; Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are separate and apart on the ticket (col. 7:20–24; where interactive game information is stored in a destiny code and a ticket identification serial number history is stored in a separate location).

20. Regarding claim 34; Kaye discloses a lottery gaming system wherein the interactive game information includes an access code configured to permit the player to access the interactive Internet game (col. 3:23–25).

21. Regarding claim 36; Kaye discloses wherein the interactive game information further includes an Internet address where the player can access the interactive Internet game (col. 9:1–3; where an on-line component for games is used, which may include the Internet).

22. Regarding claim 37, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61).

23. Regarding claims 43 – 44, Kaye discloses a lottery gaming system wherein the interactive game information is pre-printed on the lottery ticket and activated in response to a transmission of the identifier to the central computer system (col. 3:23–25) and the central computer system is further configured to transmit the interactive game information to the ticket dispenser and wherein the ticket dispenser is configured, responsive to the receipt of the interactive game information from the central computer, to print the interactive game information on the game ticket (col. 6:1–6).

24. Regarding claims 45 – 46, Kaye discloses a lottery gaming system wherein the removable covering is a scratch-off layer and wherein the removable covering includes

the interactive game information (col. 1:25–32; where a removable covering includes game information).

25. Regarding claim 52, Kaye discloses a method wherein the activating the lottery ticket occurs prior to providing the player the lottery ticket (col. 3:16–45; where a destiny code is generated and activated by a dispenser before it is given to a player, and later verified for use in an interactive game).

26. Regarding claim 54, Kaye discloses a method including crediting an account of the player if the player wins the interactive Internet game (col. 8:48–61).

27. Regarding claim 38, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61), but does not disclose that the computing device is incorporated into the lottery ticket dispenser. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the game system using separate lottery dispensing and player terminals of Kaye with an integrated lottery dispensing and player terminal in order to increase convenience for a player by providing all elements of a gaming system in one location.

28. Regarding claim 47, Kaye and Roberts disclose all the limitations of claim 27 from which claim 47 depends on; and Roberts further discloses a lottery ticket, but does not disclose a specific method of storing lottery tickets. However, Roberts teaches a lottery ticket wherein the lottery ticket is releasably coupled by lines of weakness to additional lottery tickets in a fan fold stack of lottery tickets (col. 3:29–30), in order to organize tickets for dispensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the lottery and interactive game system using tickets of Kaye with the fan folded tickets of Roberts in order to better organize tickets for dispensing.

29. Regarding claims 60 and 61, Kaye and Roberts disclose all the limitations of claims 27 and 47 from which claims 60 and 61 depend on; and Kaye further discloses wherein the computing device is further configured, responsive to receipt of an indication that the lottery ticket has not been activated for use in the interactive Internet game, to prevent the player from playing the interactive game using the lottery ticket, (col. 6:45-47).

30. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye and Roberts, as applied to claim 27 above and in view of Walker et al. (US 6,497,408 B1).

31. Regarding the analogous art combination; Kaye, Roberts and Walker all three disclose teaching regarding Lottery Systems operated on-line.

32. Regarding claim 39, Kaye and Roberts disclose a lottery gaming system, with a computing device as covered in claim 27 above, but fail to disclose a portable device. Walker discloses the computing device can be a handheld device, (Col. 5:1-8 and 22-25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention after reading Walker's disclosure, to enhance the player interface device by making it portable and handheld. Using the known technique of handheld lottery consoles of Walker, to substitute for the personal computer lottery of Kaye/Roberts would have been an obvious predictable result to one of ordinary skill.

33. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye and Roberts as applied to claim 48 above, and further in view of Mullins (US 5,158,293).

34. Regarding the analogous art combination; Kaye, Roberts and Mullins all three discloses teaching involving an on-line lottery system.

35. Regarding claim 55; Kaye and Roberts disclose all the limitations recited in claim 48 from which claim 55 depends, and although Kaye is silent about continuing the game after an instant win. Mullins discloses providing the interactive game information on the removable covering; after the removable covering has been removed by the player, receiving a tender of the lottery ticket without the removable covering for a prize in the instant win game; responsive to receiving the tender of the lottery ticket, redeeming the lottery ticket for a the prize in the instant win game; and providing the interactive game play to the player at the computing device after the player has redeemed the lottery ticket for a prize in the instant win game; the receiving at least a portion of the interactive game information from the ticket at the computing device occurs after the tender of the lottery ticket, the interactive game information being provided by the player from removable covering, (abstract, col. 2:25-63; in which Mullins covers a lottery ticket with a redeemable instant win and keeping the remainder of the ticket for accumulation of letters for the progressive win). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the very well known method of Mullins in the Kaye's and Roberts' invention to introduce yet another winning level in the game. These features are not novel but very well known methods of entertainment in the lottery arts, which yield a predictable result.

Examiner's Note

36. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed "In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Conclusion

THIS ACTION IS MADE FINAL. Finality of the previously presented claims has not been removed and no amendment to the claims has been presented in order to advance prosecution. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571) 272-2460. The examiner can normally be reached on M-F 11:00 am - 4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571) 272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3717

/F. M. L. /
Examiner, Art Unit 3717